



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,558	06/30/2003	John Claude Husband	07810.0109-01	7379

22852 7590 07/06/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

MANLOVE, SHALIE A

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/608,558	Applicant(s) HUSBAND ET AL.	
	Examiner Shalie A. Manlove	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Repeated

The Double Patenting rejections of claims 33-80 are repeated for reasons previously of record.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 33-42, 45-53, and 56-80 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,616,749. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed pigment and methods presently claimed in the application is suggested by the claims of US 6,616,749. The reference suggests the claimed pigment comprising the shape factor of at least 45, wherein having a particle distribution of at least 80% by weight of the particles have an equivalent spherical diameter less than 2 micron and wherein at least 12% by weight of the particles have an equivalent spherical diameter less than 0.25 microns. Industrial application of the composition to coat paper is also suggested by the

reference. Thus, reference suggests the pigment, method, and industrial application in a manner conducive with the invention of the application.

3. Claims 33-36, 38, 41-47, 49 and 52-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 40 of U.S. Patent No. 6,537,363. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference suggests the claimed pigment comprising the shape factor of at least 45, wherein having a particle distribution of at least 80% by weight of the particles have an equivalent spherical diameter less than 2 micron and wherein at least 12% by weight of the particles have an equivalent spherical diameter less than 0.25 microns and whose BET surface area is greater than $12 \text{ m}^2/\text{g}$. Industrial application of the composition to coat paper is also suggested by the reference.

4. Claims 33-36 and 45-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,402,826. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference suggests the claimed pigment comprising the shape factor of at least 45, wherein having a particle distribution of at least 80% by weight of the particles have an equivalent spherical diameter less than 2 micron and wherein at least 12% by weight of the particles have an equivalent spherical diameter less than 0.25 microns. Industrial application of the composition to coat paper is also suggested by the reference.

Art Unit: 1755

5. Claims 33-38, 41-42, 45-49, 52-53 and 56-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14, 19, 20-21, 23 and 24 of U.S. Patent No. 6,610,137. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference suggests the claimed pigment comprising the shape factor of at least 45, wherein having a particle distribution of at least 80% by weight of the particles have an equivalent spherical diameter less than 2 micron and wherein at least 12% by weight of the particles have an equivalent spherical diameter less than 0.25 microns. Industrial application of the composition to coat paper is also suggested by the reference.

Terminal Disclaimer

6. The terminal disclaimer filed on June 8, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of Patent Numbers 6,616,749; 6,537,363; 6,402,826; 6,610,137 has been reviewed and is NOT accepted.

7. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove
Examiner
Art Unit 1755

June 30, 2004


C. MELISSA KOSLOW
PRIMARY EXAMINER